



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re the Application of: **Tominari ARAKI et al.**

Serial Number: **10/056,973**

Filed: **January 25, 2002**

For: **OPTICAL MEMBER**

Appeal No: **Unassigned**

Confirmation No.: **3883**

Group Art Unit: **1774**

Examiner: **DICUS, TAMRA**

Atty. Docket No.: **020611**

Customer No.: **38834**

SUBMISSION OF REPLY BRIEF

Sir:

August 31, 2006

In reply to the Examiner's Answer dated July 13, 2006, a Reply Brief is submitted with this paper.

In the event this paper is not timely filed, appellant hereby petitions for an appropriate extension of time. The fee for any such extension may be charged to our Deposit Account No. 50-2866, along with any other additional fees which may be required with respect to this paper.

Respectfully submitted,

WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP

Nicolas E. Seckel

Attorney for Appellants

Reg. No. 44,373

Atty. Docket No. **020611**

Customer No.: **38834**

1250 Connecticut Avenue NW Suite 700

Washington, DC 20036

Tel: (202) 822-1100

Fax: (202) 822-1111

NES:rep

Enclosure: Reply Brief



**THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

REPLY BRIEF FOR APPELLANT

Ex parte Tominari ARAKI et al.

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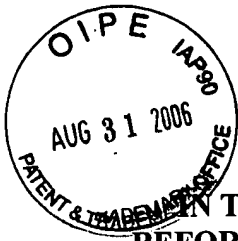
Group Art Unit: 1774

Examiner: Tamra DICUS

Nicolas E. Seckel
Reg. No. 44,373
Attorney for Appellant

WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP
1250 Connecticut Ave., N.W. Suite 700
Washington, DC 20036
Tel: (202) 822-1100
Fax: (202) 822-1111

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REPLY BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
Sir:

August 31, 2006

Appellants reply to the Examiner's Answer dated July 13, 2005.

This Reply Brief addresses the following new assertions made in the Examiner's Answer.

1. **Examiner's assertion that a motivation to combine Koike and Berler is supported in the record because "adding ink [of Berler] on Koike's cellulose acetate layer would work" and the ink of Berler is "especially suited for identification purposes" (Examiner's Answer at page 6, lines 4-3 from the bottom)**

These assertions by the Examiner are not relevant to the issue of whether it would have been obvious to combine Koike and Berler. The Examiner's choice of words ("would work," "especially suitable") expresses this deficiency: even if, for the sake of argument, it had been shown that the ink of Berler were adapted to become attached to, or were to be otherwise suitable

for, the substrate of Koike (which Appellants deny), this would not provide any suggestion or motivation to modify Koike by referring to Berler.

2. **Examiner's assertion that "one would desire to either identify the optical member of Koike at some point, prior to or after removal, using the ink of Berler for identification purposes," and that "the need for applying ink is apparent, despite Appellant's allegations, because the same cellulose acetate material is shown by Berler to be suitable for ink application and identification" (Examiner's Answer at page 7, lines 11-16).**

As a preliminary, it is noted that these assertions by the Examiner constitute prohibited hindsight, because the Examiner does not refer to any basis in the record for the alleged "desire" or "apparent need."

More generally, a mere similarity or "suitability" in certain materials used by Koike and Berler would have been insufficient to establish a "desire" or "apparent need." In other words, even if, for the sake of argument, a combination "would work," generally speaking, this does not establish suggestion or motivation to combine.

3. **Examiner's assertion that "Appellant's [sic] argue that Koike does not show an easy-releasing film" (Examiner's Answer at page 7, line 8).**

This assertion is erroneous. Appellants stated in the Appeal Brief: "Koike provides an easy-release substrate" (Appellant's Appeal Brief page 6, line 4 from the bottom). In fact, Appellants' argument is that Berler does not suggest providing ink identification anywhere on the optical element of Koike, and especially not on the easy-release substrate of Koike.

4. **Examiner's assertion that "Appellant has not limited the claims to a type of identification, nor optical member, which are broad terms and encompassed by the prior art teachings set forth above" (Examiner's Answer at page 7, lines 5-4 from the bottom)**

This assertion is also erroneous. In the last amendment, the claims were amended to specify "an optical material comprising at least one of a polarizing plate, retardation plate and a brightness enhanced plate." Berler is completely silent as to these optical materials. Entry and consideration of the amendment is requested, pursuant to the December 14, 2005 Advisory Action.

5. **Conclusion**

For the above reasons, Appellants maintain their request that the Board of Patent Appeals and Interferences reverse the Examiner's rejections of claims 10-12, 14-31, and 33-51.

In the event this paper is not timely filed, appellants petition for an appropriate extension of time. The fee for any such extension may be charged to our Deposit Account No. 50-2866, along with any other additional fees which may be required with respect to this paper.

Respectfully submitted,

WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP



Nicolas E. Seckel
Attorney for Appellant
Reg. No. 44,373

Customer No.: 38834

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Tel: (202) 822-1100
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NES:rep